

REMARKS

The Applicants respectfully request reconsideration in view of the following amendments and remarks. Claims 9 and 24 have been amended. Claims 1-8, 17-23, and 31-43 have been cancelled. No claims have been added. Accordingly, claims 9-16 and 24-30 are pending in the Application.

I. Election/Restriction

The Examiner noted that any response to the Final Office Action must include a cancellation of the non-elected claims or other appropriate action. See Final Office Action, Page 2. In response, all non-elected claims have been cancelled.

II. Information Disclosure Statement

The Examiner noted that the Final Office Action for US Application No. 11/116,466 dated April 27, 2005 would not be considered because this document was not submitted to the Examiner. See Final Office Action, Page 2. In response, the Applicants note that the Examiner of the current application is also the Examiner of US Application No. 11/116,466. Thus, the Examiner is presumed to have a copy of this Final Office Action since it was created by the Examiner. Nevertheless, the Applicants submit a copy of the Final Office Action for US Application No. 11/116,466 dated April 27, 2005 along with this response.

Accordingly, the Applicants respectfully request consideration of this document.

III. Objections to the Drawings

The Examiner has objected to the drawings under 37 CFR § 1.83(a) for allegedly failing to show every element of the claims in the drawings. See Final Office Action, Pages 2 and 3. Specifically, the Examiner alleges that the drawings fail to show the "intercept concept." See Id.

As noted by the Examiner, Figure 9 indicates that system 992 intercepts inventory from a network. Further, Figure 11, item 1124 shows where the interception operation occurs in an embodiment of the invention. Based on these portions of the drawings, we believe the interception operation recited in the claims would be clear to a person of ordinary skill in the art. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the objection to the drawings.

IV. Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claims 9-16 and 24-30 under 36 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner alleges that “file-sharing or peer-to-peer network” as recited in the claims is unclear.

In response, the Applicants have amended the claims to replace each instance of “file-sharing or peer-to-peer network” with “peer-to-peer file-sharing network.” As amended, the Applicants submit that claims 9-16 and 24-30 clearly define the subject matter recited therein. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection to claims 9-16 and 24-30 on this basis.

The Examiner has rejected claims 9-16 under 36 U.S.C. § 112, second paragraph for allegedly being incomplete for omitting essential elements. Specifically, the Examiner alleges that the operation of copying files after interception is omitted from the claims.

In response the Applicants note that the claims are not attempting to claim copying/storing the files. Instead the claims are directed at storing a list of the files stored on each computer and not necessarily the actual files themselves. Thus, the claims do not require copying the actual files as argued by the Examiner.

IV. Claim Rejections – 35 U.S.C. § 102/103

Claims 24-26 and 9-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0138471 filed by Dutta et al. ("Dutta"). Claims 13, 14, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dutta in view of U.S. Patent Publication No. 2003/0105831 filed by O'Kane ("O'Kane").

To anticipate a claim, the Examiner must show that a single reference teaches each of the elements of that claim. Thus, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In regards to claim 9, this claim recites "a transfer device adapted to intercept the list of all shared files from each computer of the plurality of computers and automatically store the list of all shared files in the database, thereby tracking file storage on the peer-to-peer file-sharing network" (emphasis added). The Examiner cites paragraphs [0041], [0059], [0060], and [0064]-[0066] of Dutta to allegedly disclose these elements of claim 9. See Final Office Action, Page 7. However, the Applicants have been unable to locate any sections therein which disclose storing the lists of shared files from each computer in a peer-to-peer file-sharing network, as recited in claim 9.

Dutta discloses a peer to peer network that acts as a distributed file sharing system. See e.g. Dutta, Paragraphs [0040] and [0045]. Each node is capable of receiving a search query from a user. See Dutta, Paragraph [0041]. The nodes apply this search query to a list of shared files and obtain a search result which is transmitted to a user. See Dutta, Paragraphs [0041] and [0059]. Upon obtaining the search results containing a listing of files meeting the parameters of the search query, the user can request to download one or more of the files. See Dutta, Paragraphs [0059] and [0060]. This method of processing a search query in a network can be embodied in the core architecture of a peer-to-peer software application or alternatively it can be embodied in a plug-in or an independent module. See Dutta, Paragraphs [0064]-[0066]. In cases were

a plug-in or an independent module are used, the plug-in and/or module will have access to the search query transmitted by the user and can monitor transactions performed by the core peer-to-peer application.

The Examiner argues that in Dutta, the list of shared files is transmitted to and stored by the user. See Final Office Action, Page 7. The list of files that meet the criteria of the search query is transmitted to the user such that he/she can download preferred files from that list. However, Dutta does not disclose *storing the list of files in a database to thereby track file storage on the peer-to-peer file-sharing network*, because Dutta only discloses using the list to enable the user to download preferred files from the list. There is no disclosure that the search results (listing of shared files) are stored in a database to thereby track file storage on the peer to peer file-sharing network.

In regards to claim 24, this claim recites “requesting a listing of an entire library of shared files from each of said plurality of computers connected to the peer-to-peer file-sharing network; receiving the listing of the entire library of shared files from the computer; and automatically storing the listing in a database, thereby tracking file storage on the peer-to-peer file-sharing network” (emphasis added). The Examiner cites paragraphs [0041], [0059], [0060], and [0070] of Dutta to allegedly disclose these elements of claim 24. See Final Office Action, Page 7. Dutta discloses a peer-to-peer node processing a search request and returning to a user a listing of files that meet the criteria of the search request. The user utilizes this list of files to download a preferred set of files from that list. However, the Applicants have been unable to locate any sections therein which disclose *automatically* storing the lists of shared files from each computer in a peer-to-peer file-sharing network in a database, thereby tracking file storage peer to peer file-sharing network.

Any dependent claims not mentioned above are submitted as not being anticipated or obvious, for at least the same reasons given above in support of their base claims.

It should be noted that not all of the assertions made in the Final Office Action, particularly those with respect to the dependent claims, have been addressed here, in the interest of conciseness. Applicant reserves the right to challenge any of the assertions made in the Final Office Action by the Examiner, with respect to the relied upon art references and how they would relate to Applicant's claim language, including the right to swear behind or otherwise remove an improper art reference.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on November 25, 2009, Applicants respectfully petition Commissioner for a two (2) month extension of time, extending the period for response to August 25, 2009. The amount of \$245.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(2) small entity will be charged to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: 24 Aug 2009

By 

Farzad E. Amiri, Reg. No. 42,261

1279 Oakmead Parkway
Sunnyvale, California 94085-4040
Telephone (310) 207-3800
Facsimile (408) 720-8383

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jessica Huester

8/24/09
Date